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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,515	01/21/2000	Surya Prakash	06618-408001	5938

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EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/489,515

Applicant(s)

PRAKASH ET AL.

Examiner

Julian A. Mercado

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1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 6 and 8-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Remarks***

This Office Action is responsive to applicant's amendment filed March 11, 2003.

Claims 1-6 and 8-26 are pending. (with claims 1-5 having been withdrawn from consideration)

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 9 are presently dependent upon claim 7 (now canceled), which renders the claims indefinite.

### ***Claim Rejections - 35 USC § 102 and 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 6, 8, 9, 11, 12, 14, 15, 17-22, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Cabasso et al. (U.S. Pat. 5,783,325)

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Claims 16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cabasso et al. as applied to claims 6, 8, 9, 11, 12, 14, 15, 17-22, 25 and 26 above.

Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cabasso et al. as applied to claims 6, 8, 9, 11, 12, 14, 15, 17-22, 25 and 26 above, in view of Kindler. (U.S. Pat. 5, 992,008)

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cabasso et al. as applied to claims 6, 8, 9, 11, 12, 14, 15, 17-22, 25 and 26 above, in view of Scherer et al. (U.S. Pat. 5,656,386)

The above rejections have been discussed in detail in a prior Office Action and will not be reiterated. The rejection(s) is maintained for the reasons of record and for the additional reasons to follow in view of applicant's present amendment and arguments for patentability therewith.

Independent claims 6, 11, 19 and 26 now recite via the present amendment "a membrane plasticizer" as part of the catalyst ink. Upon closer consideration of Cabasso, the patentees are found to teach or at least suggest this feature in column 7 line 64 et seq: "[s]uitable solvents for the polyvinylidene fluoride and carbon blend include... N,N-dimethyl acetamide ("DMA")", the solvent notably dissolving the polyvinylidene fluoride. The examiner notes that DMA is the same solvent disclosed by applicant as that which provides a plasticizing effect. Thus, the claims are anticipated, and applicant's argument that Cabasso does not include a membrane plasticizer is not found persuasive.

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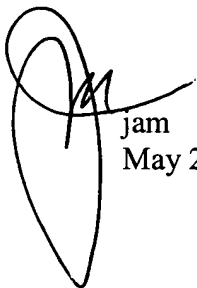
Arguments against Kindler or Scherer appear to be directed to these references failing to remedy alleged differences between Cabasso and the present claims. However, in view of Cabasso being maintained for the reasons discussed above, the 35 U.S.C. 103(a) rejection(s) in view of Kindler or Scherer is subsequently maintained for the reasons discussed in the previous Office Action.

### *Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian A. Mercado whose telephone number is (703) 305-0511. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (703) 308-2383. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



jam  
May 29, 2003



STEPHEN KALAFUT  
PRIMARY EXAMINER  
GROUP  
1700